

REMARKS

Claims 1-43 are pending in the application. By this Amendment, Applicant has canceled claims 2, 13, and 25-43 without prejudice and amended claims 1, 11, and 21-23. Claims 3-10, 12, 14-20, and 24 remain in the application without amendment.

Although Applicant believes that the invention of claims 25-43 are patentable, for the sake of expediting the allowance of the remaining claims, claims 25-43 have been canceled without prejudice and with all rights preserved to present claims 25-43 for examination in a subsequently filed continuation application. Thus, any of the objections and rejections applicable to these claims are moot.

Claims 21-23 have been amended for reasons other than related to patentability, for example, to maintain consistent terminology within the claims.

Claim 1 stands rejected under 35 USC 102(e) as being anticipated by Sheynblat '786. Applicant respectfully submits that the amendment of claim 1 overcomes this rejection.

Independent claim 1 as amended now recites, among other things, "determining a change in a communication signal received by said communication receiver, wherein said communication signal is a cellular signal transmitted from a wireless cell cite." Applicant submits that no new matter is added by this further definition of the claim, support being found, among other places, in original claim 2. Applicant submits that the cited reference does not teach the combination defined by the claim, particularly the quoted limitation. Instead, Sheynblat describes that a base station sends a message that includes the Doppler rate of change related to satellite position and velocity to a GPS receiver—not the change in the message itself. (Column 5, lines 41-58.) Thus, the claim as amended is patentably distinguishable over the cited reference.

Accordingly, the rejection of claim 1, and claims 3-10 at least by virtue of their dependency on claim 1 as amended, under 35 USC 102(e) should be withdrawn in the next Office action.

Claims 3 and 4 stand rejected under 35 USC 103(a) as being unpatentable over Sheynblat '786 in view of Abraham '797. Applicant respectfully submits that the amendment of claim 1 overcomes this rejection.

Claims 5 and 6 stand rejected under 35 USC 103(a) as being unpatentable over Sheynblat '786 in view of Ando '769. Applicant respectfully submits that the amendment of claim 1 overcomes this rejection.

Claims 7-10 stand rejected under 35 USC 103(a) as being unpatentable over Sheynblat '786 in view of Ando '769, and further in view of Pon '456. Applicant respectfully submits that the amendment of claim 1 overcomes this rejection.

Claims 11, 12, and 14-20 stand rejected under 35 USC 103(a) as being anticipated by Sheynblat '786 in view of Wysocki '338. Applicant respectfully submits that the amendment of claim 11 overcomes this rejection.

Independent claim 11 as amended now recites, among other things, "a communication receiver which receives a communication signal, wherein said communication signal is a cellular signal transmitted from a wireless cell site," and "said CSM unit determining a change in said communication signal which specifies a manner for processing said SPS signal." Applicant submits that no new matter is added by this further definition of the claim, support being found, among other places, in original claim 13. Applicant submits that the cited references do not teach or suggest the combination defined by the claim. Instead, Sheynblat describes that a base station sends a message that includes the Doppler rate of change related to satellite position and velocity to a GPS receiver—not the change in the message itself. (Column 5, lines 41-58.) Thus,

the claim as amended is patentably distinguishable over the cited reference.

Accordingly, the rejection of claim 11, and claims 12 and 14-20 at least by virtue of their dependency on claim 11 as amended, under 35 USC 103(a) should be withdrawn in the next Office action.

Claims 22-24 stand rejected under 35 USC 103(a) as being unpatentable over Sheynblat '786 in view of Wysocki '338, and further in view of Gilhousen '612. Applicant presumes that claim 21 is also included in this rejection. Applicant respectfully traverses this rejection.

In rejecting claims 21-24, the Examiner alleges that it would be obvious to one skilled in the art to combine the teachings of the cited references because "the power level could be detected and adjusted for communication." (Office Action at page 9.) To properly combine teachings of different references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art at the time of the invention, to combine the teachings to obtain the claimed subject matter. (MPEP 706.02(j).) Conclusory statements made by an examiner regarding the selection and combination of the teachings of the references do not adequately address the issue of motivation to combine. In re Sang Su Lee, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant submits that the suggestion or motivation for combining is not contained in any of the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of the invention. Rather, the Examiner is engaging in speculation and assumption as to a possible suggestion or motivation to combine the teachings. Thus, a *prima facie* case of obviousness is not established for the claims.

Accordingly, the rejection of claims 21-24 under 35 USC103(a) should be withdrawn in the next Office action.

In view of the foregoing, Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests the reconsideration and reexamination of this

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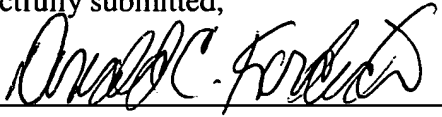
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application and the timely allowance of the pending claims. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

If there are any other fees due in connection with the filing of the response, please charge the fees to our Deposit Account No. 17-0026. If a fee is required for an extension of time under 37 CFR 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: May 16, 2003

Respectfully submitted,

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